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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,652	12/09/2003	Satish K. Sharma	10121/00203	5001

7590 12/02/2004

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EXAMINER

CHUKWURAH, NATHANIEL C

ART UNIT PAPER NUMBER

3721

DATE MAILED: 12/02/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

03

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/731,652	SHARMA ET AL.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Nathaniel C. Chukwurah	3721	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 December 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 21-39 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 21-39 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12/9/03 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>11/15/2004</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-24 rejected under 35 U.S.C. 102(b) as being anticipated by Barker et al. (US 4, 671, 445).

Barker et al. discloses a full thickness resection device comprising: a control handle (12,80) including an actuator, a working head assembly (130,132) coupled to the control handle by a flexible sheath (16) including a tissue stapling mechanism (cartridge assembly and anvil) having first and second members moving relative to one another; a first cable (24,86) extending from the actuator, a second cable (24 see rear of cartridge member) extending from the first cartridge member to control handle; a resilient member (142 spring) biasing the cartridge member (130) relative to the anvil (132). The anvil is mounted to a shaft (134) and slidably coupled to the working head assembly.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 25-27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al. in view of McGuckin, Jr. (US 5,868,760).

The anvil of Barker et al. is mounted to a shaft (134) and slidably coupled to the working head assembly.

Barker et al. lacks a pulley to which the second cable extends around to couple to the anvil. However, McGuckin, Jr. discloses similar device including a cable (146) and a pulley (152) (see also fig.14). In view of the teachings of McGuckin, Jr., it would have been obvious to one skilled in the art to provide the device of Barker et al. with pulley in order to provide the same advantage as discussed in McGuckin.

Claim 28 is rejected under 35 U.S.C. 103(a) as being unpatentable over Barker et al. in view of Shichman (US 4,488,523).

Barker et al. lacks a locking member. However, Shichman discloses similar device including a locking member (33 wire) on the control handle allowing an operator to lock the first and second tissue stapling members in a desired position relative to one another.

In view of the teachings of Shichman, it would have been obvious to one skilled in the art to provide the device of Barker et al. with lock member to provide the same advantage as discussed in Shichman.

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686

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F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 29-39 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9-19 of U.S. Patent No. 6,685,079.

Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims differ merely in the scope of the subject matter claimed; i.e. claims 29-39 of the present application are fully included in claims 9-19 of Patent '079. The application omits the features non-critical to patentability such as a working head assembly coupled to the control handle **by a flexible sheath**; a working head assembly including **a staple mechanism**; a **first threaded member** at distal end; and a **threaded channel**.

Therefore, it would have been obvious to one skilled in the art to include the features in claims 9-19 of Pat '079, in the present application, since the features of the Pat '079 encompasses the elements of the present application.

### ***Conclusion***

Refer to attachment for notice of references cited and recommended for consideration based on their disclosure of limitations of the claimed invention.

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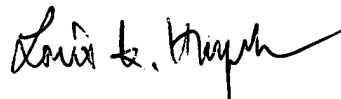
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathaniel C. Chukwurah whose telephone number is 4457. The examiner can normally be reached on M-F 6:00AM-2:30PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rinaldi Rada can be reached on (571) 272-4467. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9302 for regular communications and (703) 872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1148.

Nc

November 15, 2004

  
PRIMARY EXAMINER